

Remarks

Claims 1-28 and 30-38 are pending in the application, and each was rejected. Based on the following, reconsideration of the claim rejections is requested.

Claim Rejections — Non-Statutory Double Patenting

The Examiner has provisionally rejected claims 1-28 and 30-38 under the judicially created doctrine of obviousness type double patenting as being unpatentable over claims of co-pending application Serial No. 09/975,171 (U.S. Patent Application Publication 2003/069,856). Applicants will consider filing a Terminal Disclaimer upon indication of otherwise allowable subject matter.

Claim Rejections — 35 U.S.C. § 103

Claims 1-28 and 30-38 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,650,604 (hereinafter “*Marcous*”) in view of the book Web Security, Privacy & Commerce (hereinafter “*Garfinkel*”) and Applicants’ specification, pages 1-3 (hereinafter “*Disclosed Prior Art*”). Applicants respectfully traverse this rejection.

At the outset, Applicants assert that any combination of references including *Garfinkel* is improper because *Garfinkel* is not prior art. The present application was filed on January 3, 2002. Meanwhile, *Garfinkel* recites a copyright date of 2002 and a printing date of January 2002 (see Exhibit A). While conducting a reasonable investigation, Applicants discovered other sources, such as Amazon.com, that recite the publication date as January 15, 2002, which is consistent with the dates in the *Garfinkel* reference itself (see Exhibit B). Even a representative of the publisher of the *Garfinkel* reference, O’Reilly Media, Inc., indicated that the copyright page of the book is the best source for determining the publication date. Regardless, the MPEP states that “[a] reference is proven to be a “printed publication” ‘upon a satisfactory showing that such document has been disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art . . . can locate it.’” MPEP §2128, 8th. Ed., Rev. 3. Applicants respectfully submit any showing made

by the Examiner that *Garfinkel* became a “printed publication” prior to January 3, 2002 is unsatisfactory. At the very least, such a showing is rebutted by the evidence provided herein, particularly the *Garfinkel* reference itself.

Importantly, a tangible book reference must first be printed before it can become a “printed publication” for prior art purposes. But, merely printing copies of a reference does not render the reference a “printed publication.” Rather, only when the reference becomes accessible to the public does it qualify as a “printed publication.” MPEP §2128, 8th Ed., Rev. 3.

As previously noted, the filing date of the present application is January 3, 2002. This leaves merely two possible days that *Garfinkel* could get printed, shipped, and made accessible to the public in order to become prior art (since *Garfinkel* itself indicates that it was printed sometime in January 2002). This is quite unlikely. Regardless, there lacks any showing, much less a satisfactory one, that *Garfinkel* was accessible to the public prior to January 3, 2002. Accordingly, Applicants submit that the *Garfinkel* reference does not qualify as prior art.

Notwithstanding the disqualification of *Garfinkel* as prior art, Applicants note that there is no suggestion or motivation to combine the cited references. *Marcous* discusses a system for transferring funds electronically to a recipient through an ATM. Conversely, *Garfinkel*, a book aimed at web users, administrators, and content providers, provides topical discussions covering cryptography, SSL, PKI, digital signatures, digital certificates, privacy threats (cookies, log files, web logs, web bugs), hostile mobile code, and web publishing.

There is nothing in the prior art that suggests the desirability of combining a fully automated system of electronic fund transfers through an ATM such as taught by *Marcous* with the general web security concepts taught by *Garfinkel*, which, when viewed as a whole, have little relevance to money transfer receive transactions. As explicitly stated in the MPEP, “[t]he mere fact that references can be combined or modified does not render the result in

combination obvious unless the prior art also suggests the desirability of the combination.” MPEP § 2143.01, 8th Edition, Rev. 3. Therefore, Applicants submit that the combination of *Marcous*, *Garfinkel*, and *Disclosed Prior Art* does not form a proper basis for rejecting the claims of the present application.

Likewise, the aforementioned references are not properly combinable due to a lack of motivation to make the combination or modification proposed by the Examiner. For example, *Marcous* teaches the use of an ATM during a receiving transaction to carry out the dispensing function in electronic fund transfers. Meanwhile, the Examiner relies on *Garfinkel* for the general concept that “[c]hanging passwords, codes and/or identifiers through which to access systems, such as electronic funds, . . . is well known in the art of security technology and cryptography.” Notwithstanding this improper generalization of *Garfinkel*, there lacks any motivation to combine it with *Marcous*. The recipient in *Marcous*, after having obtained the “transaction identifying information” from the sender, goes directly to an ATM to enter the transaction identifying information and immediately receive the dispensed funds. However, the Examiner’s proposed modification of *Marcous* requires the recipient to input the transaction identifying information to the ATM, receive authorization, obtain a new code, and immediately submit that code back to the ATM so that funds may be dispensed. This is nonsensical.

Clearly, modifying the one-stage receive transaction taught by *Marcous* with the Examiner’s proposed teachings of *Garfinkel* to achieve the two-stage receive transaction recited in claim 1 of the present application is improper. Why would a recipient in *Marcous* submit one “identifier” to an ATM to get another identifier, and immediately submit that new identifier to the same ATM in order to obtain cash? As stated in the MPEP, “[o]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art.” MPEP § 2143.01, 8th Edition, Rev. 3. Therefore, Applicants submit that the lack of motivation renders the combination of *Marcous*,

Garfinkel, and *Disclosed Prior Art* an improper basis for rejecting the claims of the present application.

Even if, however, the three references are combined, the claims of the present application contain limitations which are neither taught nor suggested by the resultant combination. For example, claim 1 recites a method for performing money transfer receive transaction including “providing a confirmation code, to be issued to the recipient, if the transaction identifying information matches the transaction data stored on the host computer system.” No such limitations are taught or suggested by the combination of the cited references.

The Examiner states that “[c]hanging passwords, codes and/or identifiers through which to access systems, such as electronic funds, and the use of multiple passwords, codes and/or identifiers to access systems, such as electronic funds, is old and well known in the art of security technology and cryptography, as evidenced by *Garfinkel* (pp. 125-129).” The Examiner goes on to state that “[f]urthermore, generating new passwords, codes and/or identifiers to replace or work with old passwords, codes and/or identifiers through which to access such systems is old and well known in the art of security technology and cryptography as evidenced by *Garfinkel* (pp. 125-129).” Assuming arguendo that this is true, such generalized characterizations of the *Garfinkel* reference are not sufficient to cure the deficiencies of *Marcous*. At most, *Garfinkel* discloses that passwords are a common tool for relative identification. *Garfinkel* is insufficient to teach or suggest “providing a confirmation code, to be issued to the recipient, if the transaction identifying information matches the transaction data stored on the host computer system,” rendering the proposed modification of *Marcous* improper.

Not surprisingly, *Garfinkel* fails to provide any discussion, specific or otherwise, relating to the changing/generating of new passwords — contrary to the Examiner’s contention. At most, *Garfinkel* states that “many systems are delivered with a default password or PIN” and “default PINs are frequently not changed.” (*Garfinkel*, Table 6-1.)

First of all, the present invention is not a default password-based system. Secondly, even if it were, *Garfinkel* still does not teach or suggest the recited limitation. Moreover, *Disclosed Prior Art* fails to cure the deficiencies of the other references. Thus, Applicants respectfully believe that the § 103(a) rejection of claim 1 and the associated dependent claims is improper and should be withdrawn.

It should be noted that many dependent claims of claim 1 recite additional features that are not disclosed in the cited references, taken alone or in combination. For example, claim 6 recites “wherein the step of providing confirmation code includes providing, by the host computer system, the confirmation code to a receive transaction initiating device in communication with the host computer system.” Neither *Marcous*, *Garfinkel*, nor *Disclosed Prior Art* teach or suggests this claimed step. Contrary to the Examiner’s contention, Figure 6-2 of *Garfinkel* does not teach or suggest the recited limitation. Rather, Figure 6-2 of *Garfinkel* shows that a *user* provides a “password” over a network to a host computer system; the user who “types user name and password” is doing the providing in Figure 6-2, not the host computer system. Nor does *Disclosed Prior Art* cure the deficiencies of *Marcous*.

As another example, claim 28 recites the additional step of “receiving at the host computer system an identification code from an electronic terminal that is different from the dispensing terminal, the identification code being an anatomical image of the recipient.” The only receive transaction device discussed in *Marcous* is a dispensing terminal. *Marcous* lacks any teaching or suggestion of use of an electronic terminal that is different from the dispensing terminal in regards to the receive portion of the money transfer transaction. Likewise, *Garfinkel* makes no reference to money transfer transactions, much less money transfer receive transactions involving an electronic terminal that is different from a dispensing terminal. Although *Garfinkel* does discuss the use of biometrics for identification purposes, the Examiner’s proposed combination does not render claim 28 obvious.

Marcous merely discloses one-step recipient identification in order to receive transferred funds. The only electronic terminal differing from the dispensing terminal in the

disclosures of both *Marcous* and *Disclosed Prior Art* can be found with reference to the send transaction only. *Marcous* discloses an “initiating terminal,” which “is the medium the sender uses to create the request to electronically transfer money.” (Column 4, lines 41-52.) Similarly, *Disclosed Prior Art* discloses a “point of sale terminal” for “performing send transactions” wherein agent enters information provided by the sender. (Page 1, lines 17-23.) In order for the host computer system to receive an anatomical image of the recipient from an electronic terminal, as recited in the claim, the recipient would need to be present. However, were the recipient present during the send transaction, it would render the electronic money transfers disclosed in *Marcous* and *Disclosed Prior Art* unsatisfactory for its intended purpose. That is, the sender could just manually and directly hand over funds to the recipient, rather than resorting to an electronic fund transfer. The MPEP states that when a modification to a device renders it unsatisfactory for its intended purpose, a lack of suggestion or motivation to make the modification is indicated. MPEP § 2143.01 8th Edition, Rev. 3. Hence, Applicants respectfully believe that Examiner’s proposed modification would not have been obvious to one of ordinary skill in the art.

As yet another example, claim 35 recites additional limitation “wherein the confirmation code is not provided by the sender.” Recall that *Marcous* is directed to a system for facilitating electronic fund transfers involving a security code and PIN *provided by a sender* to a recipient during an initiating transaction, and then entered by a recipient during a dispensing transaction. Once the recipient is given both the security code and a PIN *by a sender*, the dispensing or “money transfer receive” transaction in *Marcous* is executed by: (1) the recipient inputting the security code, PIN, and amount to be dispensed at a dispensing terminal (Column 8, lines 52-67); (2) comparing the information entered by the recipient with information provided by the sender and stored in the system during an initiating transaction (Column 9, lines 24-29); and (3) dispensing funds to the recipient if the information provided by the recipient matches the information stored in the system (Column 9, lines 39-56). Again, the information entered into the system by the recipient includes the principal amount to be dispensed, the security code of the sender, and a system generated PIN issued to the sender.

These items of information *must be communicated by the sender* to the recipient (Column 4, lines 12-21; Column 7, lines 58-62; Column 8, lines 58-65).

Marcous discloses that once the amount to be dispensed, the security code of the sender, and the system generated PIN issued to the sender (transaction identifying information) are inputted by the recipient during the dispensing transaction, and matched with the transaction data stored on the system, funds are dispensed to the recipient and the transaction is “completed.” (Column 9, lines 39-56.) No additional “codes” are provided to the recipient. Thus, *Marcous* suggests that all information needed by the recipient to dispense funds is provided by the sender. Indeed, it “must be communicated by the sender to the recipient.” (Column 4, lines 11-15.) Therefore, it is respectfully believed that it would not have been obvious to one of ordinary skill in the art to provide the recipient with “codes” for access to transferred funds that were not provided by the sender, because *Marcous* explicitly and repeatedly states that this information must be provided to the recipient *by the sender*. Moreover, it is respectfully believed that it would not have been obvious to provide additional “codes” to the recipient that are not provided by the sender, since the transaction, according to *Marcous* is complete once the information provided by the sender to the recipient is matched (following input of the information by the recipient) and funds are dispensed. If anything, *Marcous* teaches away from the proposed limitation of claim 35.

Contrary to the Examiner’s contention, *Garfinkel* fails to disclose “providing confirmation code, to be issued to the recipient, if the transaction identifying information matches the transaction data stored on the host computer system . . . wherein the confirmation code is not provided by the sender.” The Examiner relies on Figure 6-2 of *Garfinkel* to support his rejection. However, Figure 6-2 fails to suggest “providing a confirmation code, to be issued to the recipient” much less “wherein the confirmation code is not provided by the sender.” Rather, *Garfinkel* merely discloses that a user “types user name and password” into a computer that gets transmitted over a network to a host computer system. Thus, the § 103(a) rejection of claim 35 is believed to be improper and should be withdrawn.

Referring now to claim 20, the differences between the claimed invention and the cited references are similar to the differences between claim 1 and the cited references. Accordingly, Applicants assert that the arguments made in reference to claim 1 apply to claim 20. It should be noted that many dependent claims of claim 20 recite additional features that are not disclosed in the cited references, taken alone or in combination. For example, claim 37 recites the additional limitation “wherein the identification number and the confirmation code are not provided by the sender.” As another example, claim 38 recites the additional limitation “wherein the receive transaction initiating terminal is different than the dispensing terminal.”

In view of the foregoing, Applicants respectfully request that the Examiner withdraw the obviousness rejection and pass these claims through to allowance.

Interview Summary

Applicants would like to express their gratitude to the Examiner and the Examiner's SPE for granting an interview with the undersigned to discuss the pending Office Action. The undersigned appreciates the genuine effort on the part of the Examiners to reach an agreement with respect to the claims.

Regarding the substance of the interview, Applicants argued that the Garfinkel reference was not valid prior art, because the Examiner had not made a “sufficient showing” that Garfinkel was a “printed publication” prior to the filing date of Applicants’ invention. Alternatively, Applicants would present evidence to rebut any showing made by the Examiner, or otherwise render it unsatisfactory.

At the SPE’s request, the undersigned remarked on the general contents of the presentation to be made in this reply. This included, among other things, comments reflecting a discussion the undersigned had via telephone with a customer service representative of the publisher of the Garfinkel reference. As previously noted, the representative suggested that

the reference itself was the better source for determining when the reference became a "printed publication" for prior art purposes. Contrary to the Examiner's summation of the interview, it should be noted that the undersigned never indicated that he had "secured information from Garfinkel's publisher refuting the publication date for said reference provided by the Examiner." Nor did the SPE indicate that allowance hinged on such a specific showing. In any event, the undersigned discussed other evidence that contradicted the publication date provided by the Examiner. The SPE indicated that if such a presentation is made in a subsequent reply (enclosed herein), he could not see any reason that the application should not proceed toward allowance.

CONCLUSION

Applicants have made a genuine effort to respond to each of the Examiner's rejections in advancing the prosecution of this case. Applicants believe that all formal and substantive requirements for patentability have been met and that this case is in condition for allowance, which action is respectfully requested. Moreover, the Examiner is invited to contact the undersigned if any questions arise or any additional issues need to be resolved concerning the present application.

A check in the amount of \$120 is enclosed to cover the Petition fee. Please charge any additional fees or credit any overpayments as a result of the filing of this paper to our Deposit Account No. 02-3978.

Respectfully submitted,
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